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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,795	10/24/2003	Robert Shih	15436.247.1.1	9310

22913 7590 01/17/2007

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EXAMINER	
AKANBI, ISIAKA O	
ART UNIT	**PAPER NUMBER**
2877	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/693,795	SHIH ET AL.	
	Examiner	Art Unit	
	Isiaka O. Akanbi	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02 November 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement file 02 November 2004 has been entered and reference considered by the examiner.

Drawings

The examiner approves the drawings filed 24 October 2003.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to how "arm is adapted to apply pressure between said cap and said header" perform the function of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/693,773. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader than the claim of the copending Application No. 10/693,773. They correspond as follows:

10/693,795	10/693,773
1	1,18
2	7
3	
4	
5	7,9
6	
7	18, 19
8	19
9	22
10	22
11	
12	
13	
14	1, 27, 28
15	
16	
17	3
18	4
19	15,16

The difference between the present application and the copending application is that the present application claimed a cap mounted to header, comprising a body and a lens, having a second optical axis, mounted to said body, said cap being mounted to said header by at least one weld point as said lens is positioned relative to said photonic device so that said first optical

axis and said second optical axis are approximately aligned while the copending application claimed measuring the alignment of the lens in the cap to the photonic device in the header is to measure the concentricity. Both are lens alignment process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9, 11-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimura et al. (5,666,450).

As regard to claim 1, Fujimura discloses a packaged optical device comprising of the following:

a header (3/110) having a base plate, a photonic device (16) mounted to said header, said photonic device having a first optical axis (laser axis) and a cap (5/85/115) mounted to said header, said cap comprising a body (16) and a lens (6/114), having a second optical axis (lens axis), mounted to said body, said cap (5/85/115) being mounted to said header (3) by at least one weld point as said lens is positioned relative to said photonic device so that said first optical axis and said second optical axis are approximately aligned (figs. 1 and 17)(col. 2, line 5-7)(col. 2, line 33-35).

As to claim 2, according to claim 1, Fujimura discloses photonic device is a laser (1)(figs. 1 and 2)(col. 1, line 53-55)(col. 2, line 44-46)

As to claim 3, Fujimura discloses photonic device is a photo diode (2)(col. 2, line 28 and line 49-50).

As to claim 5, Fujimura discloses a ball lens (6)(figs. 1 and 2)

As to claim 6, Fujimura discloses an optical detector (2).

As regard to claim 7, Fujimura discloses a method of aligning a cap (5/85/115) having a lens (6) to a header (3) holding a photonic device, the method comprising:

a step for viewing (PSD)(col. 8, line 55-65) said photonic device through said lens (6), a step for moving said cap relative to said header to position a first optical axis of said lens

proximate a second optical axis of said photonic device and a step for mounting said cap to said header to hold said cap in alignment with said photonic device (figs. 1 and 2)(see abstract)(col. 1, line 52-col. 2, line 1-42).

As to claim 9, Fujimura discloses a step for viewing photonic device by a video display system (col. 8, line 55-65).

As to claims 11 and 12, Fujimura discloses a step for moving said cap relative to said header until a center of said lens is within a preselected calibration distance of said photonic device, a step for positioning said header for movement in at least two of an x- direction, a y-direction, and a z-direction, a step for positioning said cap for movement in at least two of an x-direction, a y-direction, and a z-direction, and a step for moving at least one of said header and said cap in at least one of an x-direction, a y-direction, and a z-direction (figs. 2 and 10)(col. 2, line 39-col. 3, line 1-5)(col. 14, line 25-30).

As to claim 13, Fujimura discloses a step for welding said cap to said header at at least one point (figs. 1 and 2)(col. 2, line 5-7).

As regard to claim 14, Fujimura discloses an apparatus to align a cap having a lens with a first optical axis to a header holding a photonic device with a second optical axis comprising of the following:

a capture assembly (16) adapted to hold said header (3) having said photonic device, said capture assembly being movable relative to said cap (figs. 2, 10 and 17);

an arm (15/96/123/122) configured to support said cap, said arm being adapted to support said cap without obstructing a view of at least a portion of said lens (6/114) and

a visual display system (PSD)(col. 8, line 55-65)(fig. 11) adapted to depict a position of said cap relative to said photonic device (fig. 5) as said capture assembly moves relative to said cap to align said first optical axis (laser axis) and said second optical axis (lens axis)(figs. 2 and 10)(col. 2, line 39-col. 3, line 1-5)(col. 14, line 25-30).

As to claim 16 Fujimura discloses at least one welding system, said at least one welding system in electrical communication with said arm and said capture assembly (figs. 1-2,10,15,16)(col. 2, line 5-42)(col. 13, line 55-57).

As to claim 17 Fujimura discloses at least one camera and at least one video display (col. 8, line 55-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (5,666,450), as applied to claims 1. The reference of Fujimura teaches of the packaged optical device of claims 1 and 7, comprising joining/welding cap (5) to base plate of header (3)(figs. 1 and 2), however the reference of Fujimura is silent regarding the specific type of sealing/joining/welding process use. The use of hermetic seal/join metallic header to cap is known in the art. Therefore it would have been obvious to one having ordinary skill in the art at the time of invention to use a hermetic seal to join a cap to base plate header for the purpose of permanently weld the header and the cap.

Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (5,963,696) in view of Staver et al. (5,621,831).

Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Fujimura in view of Staver. The reference of Fujimura teaches of the features of claims 10 and 18, comprising at least one video display (i.e. screen)(col. 8, line 55-65), however the reference of Fujimura is silent regarding a step for overlaying a calibration pattern on said video display. The reference of Staver teaches of visual display system that includes a video overlay including at least one calibration feature (fig. 3)(col. 5, line 4-30). Therefore it would have been obvious to one having ordinary skill in the art at the time of invention to provide visual display system that includes a video overlay including at least one calibration feature that allows laser to fiber alignment for the purpose of aiding a person to align accurately.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (5,963,696 in view of the examiner Official Notice.

As to claim 18, the reference of Fujimura teaches of an optical assembly comprising camera (CCD)(col. 8, line 55-65), however the reference of Fujimura is silent with regard to said camera further comprising a zoom lens. The examiner wishes to take Official Notice of the fact that the use of a camera with zoom lens would have been well known as evident by Mazumder et al. (5,446,549). It would have been obvious to one having ordinary skill in the art at the time of invention to provide a camera comprising a zoom lens for the purpose of zoom in or out camera to obtain a better image of the alignment.

Additional Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed in the attached form PTO-892 teach of other prior art packaged optical device that may anticipate or obviate the claims of the applicant's invention.

Conclusion

Official Notice

Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice. Applicant must seasonably challenge well known statements and statements based on personal knowledge. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made. See MPEP 2144.03, paragraphs 4 and 6.

Fax/Telephone Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isiaka Akanbi whose telephone number is (571) 272-8658. The examiner

can normally be reached on 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on (571) 272-2059. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isiaka Akanbi
January 2, 2007

Gregory J. Toatley, Jr.
Supervisory Patent Examiner